

## **REMARKS / ARGUMENTS**

In response to the Office Action of August 24, 2011, Applicants have amended claims 1, 4, 12 and 13, added new claim 21, and canceled claims 2-3, 6-8, and 15-20, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration of all pending claims is respectfully requested.

The Examiner has rejoined claims 2-3, 7-8 and 10-13 with the previously elected claims, but has kept claims 15-20 withdrawn from consideration. By this amendment, claims 15-20 have now been canceled. Applicants reserve the right to file one or more continuation and/or divisional applications directed to subject matter of any claim canceled from this application. Applicants acknowledge the allowance of claim 1 and claims 9-10.

### **Objections to the Claims**

Claim 13 has been objected to as dependent upon an objected base claim (claim 2) but the Examiner has indicated that claim 13 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claim. By this amendment, claim 13 has been amended to depend from allowed claim 1. Withdrawal of the objection to claim 13 is therefore respectfully requested.

Claims 3, 7 and 8 have been objected to as allegedly not complying with the requirements of 37 C.F.R. §1.821-1.825, which requires that references be made to a sequence by the use of a sequence identifier. Since claims 3, 7 and 8 have been canceled, the objection is moot. Claim 4 has also been objected to for misspelling the word "cyclin". By this amendment, claim 4 has been amended to correct the spelling of "cyclin".

### **Rejections under 35 U.S.C. § 112, first paragraph**

Claim 6, and claims 7-8 dependent thereon, have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description

requirement. Claims 6-8 have been canceled without prejudice, rendering the rejection of such claims moot.

Claim 14 has been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. It is the position of the Examiner that since claim 14 is drawn to plants obtainable by a method according to claim 1, it is drawn to plants transgenic for any cyclin A nucleic acid molecule operably linked to a seed-preferred promoter and encoding a cyclin A protein and exhibiting the phenotypic characteristics recited in claim 1.

As presently amended, claim 14 depends from claim 4, and therefore is drawn to plants transgenic for the cyclin A2 molecule. As taught on page 6 of the present application:

A "cyclin A amino acid" or "cyclin A protein" as defined herein is taken to mean an amino acid which in its native form comprises motif 1, which is represented as: W L V/I E V S/A D/E D/E Y K/R/T L (motif 1), where a backslash (/) means 'or', i.e. where 'V/I' means V or I. The presence of motif 1 in an amino acid sequence allows the sequence to be identified as a cyclin A rather than as any other type of cyclin.

The term "cyclin A2 amino acid" or "cyclin A2 protein" as defined herein is any amino acid which in its native form comprises motif 1 as identified above and additionally motif 2, which is represented as: E L T L V/I/T/M D/E/M Y T/S/H/P/G F R/L L/R/K/N F L P S (motif 2), wherein the presence of at least two of the residues identified (--T-----F--F----) (and underlined above) allow the sequence to be identified as a cyclin A2-type rather than as any other cyclin A. The dashes (-) above represent amino acid residues, where one dash is equal to one amino acid residue in a corresponding position in motif 2.

Applicants respectfully submit that the proper test for sufficiency of description in a patent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time, of the later claimed subject matter." *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Exactly how the specification allows one skilled in the art to recognize that an applicant had possession of the claimed invention is not material. *In re Smith*, 481, F.2d 910, 178 USPQ 279 (CCPA 1973). Typically, an applicant conveys that he or she is in

possession of the invention by use of descriptive means such as "words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood v. American Airlines*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). To comply with the written description requirement, it is not necessary that the application describe the invention *ipsis verbis*. *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971). What is required is that an ordinarily skilled artisan recognize from the disclosure that applicants invented the subject matter of the claims, including the limitations recited therein. *Smith*, 481 F.2d at 915, 178 USPQ at 284.

Thus, it has been well settled that the written description requirement of 35 U.S.C. § 112, first paragraph, can be satisfied without express or explicit disclosure of a later-claimed invention. See e.g. *In re Herschler*, 591 F.2d 693, 700, 200 USPQ 711, 717 (CCPA). In that particular case, the court stated: "[t]he claimed subject matter need not be described in *haec verba* to satisfy the description requirement. It is not necessary that the application describe the claim limitations exactly, but only so clearly that one having ordinary skill in the pertinent art would recognize from the disclosure that appellants invented processes including those limitations." (citations omitted). See also *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000) ("In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *en haec verba* support for the claimed subject matter at issue.")

It is respectfully submitted that the consensus sequences recited in claims 1 and 4, (SEQ ID NOs:6 and 7), are described clearly in the specification, so that one skilled in the art would recognize that Applicants invented the subject matter presently recited by claim 14. In view of the remarks hereinabove, withdrawal of the rejection of claim 14 under the written description provision of 35 U.S.C. §112, first paragraph, is respectfully requested.

#### **Rejections under 35 U.S.C. §112, second paragraph**

Claim 4, and claims 6-8 and 11-12 dependent thereon, have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In

particular, claim 4 has been deemed indefinite by the Examiner for reciting "further comprising". As the Examiner has suggested, claim 4 has been amended to replace "further comprising" with "comprising". Claims 6-8 have been canceled by this amendment.

Claim 12 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has alleged that the phrase "such as" renders claim 12 indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

In response thereto, the phrase "such as salt stress" has been deleted from claim 12. New claim 21 depends from claim 12 and recites: "The method according to claim 12, wherein said abiotic stress is salt stress." Withdrawal of the rejection of claim 12 under 35 U.S.C. § 112, second paragraph, is therefore warranted.

#### **Rejections under 35 U.S.C. § 112, fourth paragraph**

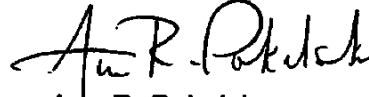
Claim 6, and claims 7-8 dependent thereon, have been rejected under 35 U.S.C. §112, fourth paragraph, for failing to further limit the subject matter of a previous claim. Since claims 6-8 have been canceled from this application, the rejection is moot.

#### **Double Patenting Rejections**

Claims 2 and 3 have been objected to under 37 C.F.R. §1.75 as alleged substantial duplicates of claim 1. Claim 7 and 8 have also been objected to under the same rule, as alleged substantial duplicates of claim 6. Since claims 2, 3, 7, and 8 have been canceled by this amendment, the objection is moot.

In view of the foregoing remarks and amendments, it is firmly believed that the present application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ann R. Pokalsky". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

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